

U.S. Application No. 09/608,184 Examiner Christopher J. Brown Art Unit 2134
37 CFR 1.116 Amendment & Request for Reconsideration of Advisory Action mailed on April 28, 2005

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RESPONSE

In response to the Final Office Action dated January 27, 2005 and in response to the Advisory Action mailed on April 28, 2005, Assignee respectfully requests reconsideration based on the following remarks. ASSIGNEE RESPECTFULLY SUBMITS THAT THE PENDING CLAIM - CLAIM 41 - IS IN CONDITION FOR ALLOWANCE, OVERCOMES THE CITED 35 USC § 132 OBJECTION, AND DOES NOT RAISE ANY NEW ISSUES THAT WOULD REQUIRE FURTHER CONSIDERATION AND/OR SEARCH. All other claims - claims 1-40 and claims 42-55 - are canceled in this response. Consequently, claim 41 is in condition for allowance.

The United States Patent and Trademark Office (the "Office") refused to enter the 1.116 Amendment & Response mailed on March 28, 2005 stating that the "[a]mended claims include new issues such as including multiple request to a merchant per transaction." Consequently, the Assignee (1) cancels all claims that were rejected in the Final Office Action, (2) cancels claim 55 introduced in the 1.116 Amendment & Response mailed on March 28, 2005, and (3) again presents claim 41 with the agreed upon amendment to overcome the 35 USC § 132 objection. Thus, the only pending claim is claim 41 and the objection to claim 41 has been overcome. Thus, the Assignee respectively submits that claim 41 is ready for allowance and requests reconsideration pursuant to 37 CFR §1.116. *See also*, MPEP §§ 714.12 and 714.13.

March 1, 2005 Interview:

On March 1, 2005, an in person interview (hereinafter referred to as "the Interview") was held with Christopher Brown (Examiner), Gregory Morse (Examiner Brown's Supervisor), Samuel Zellner (Inventor), and Bambi Walters (Attorney for Assignee). During the Interview, the participants discussed the objection and rejections of the January 27, 2005 Office Action including claim 41 and agreed that the steps of "receiving a request to connect the payer with the help communications address for assistance with the financial transaction" and "initiating a

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communications connection among the payer and the help communications address" are supported in the application.

§132 Rejection:

In the reason for objecting to the claim 41, Examiner Brown asserted that "sending the notification message to the help communications address" introduced new matter. Office Action, p. 2. Assignee has rewritten claim 41 in independent claim format to include the limitations of base claim 36 and has further amended the claim to remove the step of "sending the notification message to the help communications address." Amended claim 41 is presented below:

[c41] A method for monitoring a commercial transaction for a payer, comprising the steps of:

- initiating the commercial transaction;
- sending an authorization request to a processing center, wherein the authorization request comprises an amount of the commercial transaction;
- receiving the authorization request, including an identification of the payer, in a computer in a processing center;
- determining whether the payer is a subscriber of the commercial transaction monitoring service;
- continuing processing of the commercial transaction if the payer is not a subscriber to the commercial transaction monitoring service; and
- if the payer is a subscriber to the commercial transaction monitoring service:
 - obtaining a notification address corresponding to the identification of the payer;
 - creating a notification message using the notification address, wherein the notification message comprises a help communications address for assistance with the commercial transaction and wherein the notification message further comprises a merchant name, a merchant address, the amount of the commercial transaction, a date of the commercial transaction, a time of the commercial transaction, a name of the payer, and a reference number of the commercial transaction;
 - sending the notification message to the notification address;
 - receiving a request to connect the payer with the help communications address for assistance with the financial transaction; and
 - initiating a communications connection among the payer and the help communications address.

U.S. Patent Application No. 09/608,184, claim 41.

During the Interview, the participants agreed that the steps of "receiving a request to connect the payer with the help communications address for assistance with the financial

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transaction" and "initiating a communications connection among the payer and the help communications address" are supported in the application. Further, these steps – "receiving a request to connect the payer with the help communications address for assistance with the financial transaction" and "initiating a communications connection among the payer and the help communications address" – have not been objected to nor rejected to by the Office.

Consequently, the Assignee respectfully requests that Examiner Brown remove the objection of claim 41. **THERE ARE NO OTHER OBJECTIONS NOR ARE THERE ANY REJECTIONS OF CLAIM 41, AND ASSIGNEE RESPECTFULLY SUBMITS THAT CLAIM 41 IS IN CONDITION FOR ALLOWANCE PURSUANT TO 37 CFR §1.116. SEE ALSO, MPEP §§ 714.12 AND 714.13.**

Furthermore in regards to claim 41, Assignee respectfully asserts that if Examiner Brown seeks to maintain this objection, then maintaining this objection is a violation of due process. If the Office wishes to factually support this objection, then another office action is required. This other office action must follow the requirements of MPEP § 706.03(o) and be reexamined. And, if a subsequent office action rejects claim 41, then the Office cannot issue a final office action — that is, the Assignee must be given an opportunity to rebut any new rejection of claim 41. ANY OTHER ACTION IS A VIOLATION OF DUE PROCESS.

§103 Rejections:

Claims 1-40 and claims 42-54:

In the Office Action, the Office rejected claims 1-27, 29-31, 33-35, and 37-54 under 35 U.S.C. § 103(a) as being unpatentable over Blonder (U.S. Patent No. 5,708,422) in view of Bartoli (U.S. Patent No. 6,047,268), rejected claims 28, 37, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Blonder in view of Bartoli in view of Goldsmith (U.S. Patent No. 6,064,990), and rejected claims 32 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Blonder in view of Bartoli and in view of Bickham (U.S. Patent No. 5,530,438). Assignee has canceled claims 1-40, and, consequently, the rejections of claims 1-40 is moot.

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New claim presented in March 28, 2005 1.116 Amendment and Response:

Claim 55:

In this 1.116 Response and Amendment to the April 28, 2005 Advisory Action and to the January 27, 2005 Final Office Action, Assignee has canceled claim 55. Consequently, any assertion that claim 55 includes "new issues such as including multiple request to a merchant per transaction" is moot.

CONCLUSION

THE OBJECTION OF CLAIM 41 HAS BEEN OVERCOME. FURTHER, THE EXAMINER AND HIS SPE AGREED THAT THE STEPS OF "RECEIVING A REQUEST TO CONNECT THE PAYER WITH THE HELP COMMUNICATIONS ADDRESS FOR ASSISTANCE WITH THE FINANCIAL TRANSACTION" AND "INITIATING A COMMUNICATIONS CONNECTION AMONG THE PAYER AND THE HELP COMMUNICATIONS ADDRESS" ARE SUPPORTED IN THE APPLICATION. NO NEW ISSUES ARE PRESENTED IN CLAIM 41 - THAT IS, CLAIM 41 CONTAINS NO NEW LANGUAGE, LIMITATIONS, AND/OR FEATURES THAT HAS NOT BEEN PREVIOUSLY PROVIDED FOR EXAMINATION BY EXAMINER BROWN IN THE JANUARY 27, 2005 FINAL OFFICE ACTION.

THERE ARE NO REJECTIONS TO CLAIM 41 - THAT IS, THE OFFICE (USPTO) HAS NOT AND NEVER HAS REJECTED CLAIM 41.

ASSIGNEE RESPECTFULLY SUBMITS THAT CLAIM 41 IS IN CONDITION FOR ALLOWANCE PURSUANT TO 37 CFR §1.116. SEE ALSO, MPEP §§ 714.12 AND 714.13.

THEREFORE, ASSIGNEE RESPECTFULLY SOLICITS A NOTICE OF ALLOWANCE FOR CLAIM 41.